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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/197,844	11/23/1998	GAD JANAY	030	1758

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EXAMINER
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PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/197,844

Applicant(s)

JANAY, GAD

Examiner

CESAR B. PAULA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to the amendment filed on 12/27/2005.

**This action is made Final.**

2. In the amendment, claims 1-18 are pending in the case. Claims 5, 10-11, and 15 are independent claims.

### ***Drawings***

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-11, and 13-18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus et al, hereinafter Warmus (Pat.# 6,327,599, 12/4/01, filed 6/7/95), in view of Barnes, "10 Minute Guide To Windows 3.1", SAMS, 1992, p.119-123.

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Regarding independent claim 1, Warmus discloses automatically intercepting a print job, of publishing material, such as a book containing fixed information, and variable data, such as “Addressline1, Pricel” etc., created by a publisher—*providing data constituting a document that is meaningful to a layperson as a final printable document--*, sent to a printer which completes the print job and adding the additional variable information, which contain additional customized information. New information is added onto a static information template to produce several documents containing different information in a format different from the format originally sent by the user—data and template— (c.3, L.8-67, c.5, L.61-c.7, L.67, c.8, L.1-37, 47-56, col.9, lines 22-30). Warmus fails to explicitly disclose *a print spool associated with the printer*. Barnes teaches a print manager spooler for feeding a print job to a designated printer (p.119-120). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Warmus, and Barnes and provide a print spooler to keep track of the print jobs sent by the user, because Barnes teaches above a print manager for holding print jobs not printed by the printer. This would provide the benefit of tracking the printing progress, and keeping the print jobs in a queue, instead of losing the print jobs after sent to the printer from the user’s computer.

Furthermore, Warmus teaches the printing of additional information related to a print job. The additional information is retrieved from a database using the variable data in the templates for retrieving additional information from the database or as a key for the database (c.3, L.8-67, c.5, L.61-c.6, L.67).

Regarding claim 2, which depends on claims 1, Warmus teaches the printing of various

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books or book versions from the same single print job (col.7, lines 37-67).

Regarding claim 3, which depends on claims 1, Warmus teaches the printing of various books or book versions containing different or variable information which changes from book to book (col.7, lines 40-67).

Claims 5-6 are directed towards a tool for implementing the tool of claims 1-2, and therefore are similarly rejected.

Regarding claim 7, which depends on claim 5, Warmus discloses the intercepting of a document template—*original format*— to be printed and using this information for the retrieval of variable data from a database. New information is added onto the template to produce several documents containing different information in a double-side printing format (col.3, line 7-col.4, line 12, col.6, lines 1-67, and col.7, line1-col.8, lines 1-67).

Claims 8-10, and 13-14 are directed towards a formatting tool for implementing the tool of claims 3, 3, and (1 & 3), 1, and 3, and therefore are similarly rejected.

Regarding independent claim 11, Warmus discloses automatically intercepting a print job, with static, and variable information, such as “Addressline1, Price1” etc., —*providing data constituting a document that is meaningful to a layperson as a final printable document--first, and second portion--* sent to a printer and adding additional variable information from a database

based upon the variable information or *keys*, which contain additional customized information. New information is added onto the template to produce several documents containing different information in a format different from the format originally sent by the user—data and template. One document having information not present in the other (c.3, L.8-67, c.5, L.61-c.7, L.67).

Regarding independent claim 15, Warmus teaches the printing of various books or book versions using template files, which have fixed data, and information for identifying locations for printing variable information, such as “Addressline1, Price1” etc., —*said information is meaningful to a layperson as a final printable document--* (col.,6, lines 1-67, col.7, lines 37-67, col.9, lines 22-30).

Warmus discloses automatically intercepting a print job, of publishing material, such as a book containing fixed information created by a publisher, sent to a printer which completes the print job and adding additional variable information, which contain additional customized information. New information is added onto a static information template to produce several documents containing different information in a format different from the format originally sent by the user—data and template— (c.3, L.8-67, c.5, L.61-c.7, L.67, c.8, L.1-37, 47-56).

Moreover, Warmus teaches the formatting and interception of data before it reaches the printer, and inserting variable data located in a database (col.5, lines 60- col.6, line 67). Warmus fails to explicitly disclose *a print spool*. Barnes teaches a print manager spooler for feeding a print job to a designated printer (p.119-120). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Warmus, and Barnes, because Barnes teaches above a print manager for holding print jobs not printed by the printer.

This would provide the benefit of keeping the print jobs in a queue, instead of losing the print jobs.

Furthermore, Warmus fails to explicitly disclose *parsing the identification segment*. It would have been obvious to one of ordinary skill in the art at the time of the invention to have parsed to identify the segment, because Warmus teaches the reading of variable template data to identify where to retrieve, and how to format the variable data (col. 6, lines 1-col.7, line 67).

Claims 16-18 are directed towards a method for implementing the tool of claims 2, 2, and 3, and therefore are similarly rejected.

6. Claims 4, and 12 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus, in view of Barnes, and further in view of Ikenoue et al, hereinafter Ikenoue (Pat. # 5,987,127, 11/16/99, filed on 7/15/97).

Regarding claim 4, which depends on claim 3, Warmus discloses the intercepting of a document template—*original format*— to be printed and using this information for the retrieval of variable data from a database (col.3, line 7-col.4, line 12, col.6, lines 1-67, and col.7, line1-col.8, lines 1-67). Warmus fails to explicitly disclose *whether or not information is confidential*. Ikenoue teaches the embedding of additional data about a document, such as whether or not a document is secret, onto hard copies of a document for security and copyright purposes (col.2, lines 24-67, and col.5, lines 1-col.6, line 67). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of

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Warmus, Barnes, and Ikenoue, because Ikenoue teaches above an effective document copy management tool.

Regarding claim 12, which depends on claim 5, Warmus discloses the intercepting of a document template—*original format*— to be printed and using this information for the retrieval of variable data from a database (col.3, line 7-col.4, line 12, col.6, lines 1-67, and col.7, line1-col.8, lines 1-67). Warmus fails to explicitly disclose fails to explicitly disclose *second portion is a confidential portion*. Ikenoue teaches the embedding of additional data about a document, such as whether or not a document is secret, onto hard copies of a document for security and copyright purposes (col.2, lines 24-67, and col.5, lines 1-col.6, line 67). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Corona, Barnes, and Warmus, and Ikenoue, because Ikenoue teaches above an effective document copy management tool.

### ***Response to Arguments***

7. Applicant's arguments filed 12/27/2005 have been fully considered but they are not persuasive.

Regarding claims 1, 5, 10, 11, and 15, the Applicant submits that the identifying entries of Warmus are meaningless to a layperson when printed (page 8, parag.1-2). The Examiner disagrees, because Warmus teaches that the variable data represents fields in a database, such as “Addressline 1”, “Price1”, etc. (col.9, lines 22-30). The variable data is meaningful, which when read, it indicates to the layperson what type of data is to be inserted into the book.



Moreover, the Applicant indicates that Warmus fails to teach that the data intercepted when it is sent from a print spool to a printer, and that there is no spool (page 8, parag.3-page 10). The Examiner disagrees, because Warmus teaches automatically intercepting a print job sent to a printer and adding additional variable information, which contain additional customized information. New information is added onto the template to produce several documents containing different information in a format different from the format originally sent by the user—data and template (c.3, L.8-67, c.5, L.61-c.7, L.67, c.8, L.47-56). The variable information is added after the document has been sent to the printer. Warmus fails to explicitly disclose *a print spool associated with the printer*. Barnes teaches a print manager spooler for feeding a print job to a designated printer (p.119-120). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Warmus, and Barnes and provide a well-known print spooler(as taught by Barnes) to keep track of the print jobs sent to the printer, since the variable data processing is performed after the print process has been started by the user. In other words, the spool would be located between the computer, and the printer, because Barnes teaches above a print manager for holding print jobs not printed by the printer. This would provide the benefit of keeping the print jobs in a queue, instead of losing the print jobs after sent to the printer from the user's computer.

#### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:  
Commissioner for Patents  
P.O. Box 1450

Alexandria, VA 22313-1450


Or faxed to:

Application/Control Number: 09/197,844

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- (571)-273-8300 (for **all** Formal communications intended for entry)

  
**CESAR PAULA**  
**PRIMARY EXAMINER**  
3/16/06